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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/971,172 11/14/97 GOODMAN

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EXAMINER

WEATHERSPOON, J

ART UNIT

PAPER NUMBER

1645

13

DATE MAILED: 10/14/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/971,172

Applicant(s)
Goodman et al.

Examiner
John K. Weatherspoon

Group Art Unit
1645



☒ Responsive to communication(s) filed on 5/18/99 and 7/29/99

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 10-67 is/are pending in the application.

Of the above, claim(s) 43-49 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 10-42 and 50-67 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). _____

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. Applicants amendment and response dated 5/18/99, and supplemental amendment dated 7/29/99, have been entered into the record as Paper Nos. 11 and 12 respectively. Claims 10-67 are pending. Newly submitted claims 43-49 are directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: applicants original election of Group II was drawn to nucleic acid encoding Robo protein; however, newly submitted claims 43-49 are drawn to methods for modulating function or morphology of a target cell. Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, newly submitted claims 43-49 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03. A complete reply to this final rejection must include cancellation of nonelected claims 43-49 or other appropriate action (37 CFR 1.144) See MPEP § 821.01. Claims 10-42 and 50-67 are under examination.

2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Information Disclosure Statement

3. Applicants' Information Disclosure Statement dated 3/24/99 has been entered into the record as Paper No.9. However, the listing of references in the specification (e.g. pages 35-36 of the specification) is not a proper information disclosure statement. 37 CFR 1.98(b) requires a list of all patents, publications, or other information submitted for consideration by the Office, and

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MPEP § 609 A(1) states, "the list may not be incorporated into the specification but must be submitted in a separate paper." Therefore, unless the references have been cited by the examiner on form PTO-892, they have not been considered.

Claim Rejections - 35 USC § 112

4. New grounds for rejection: Claims 10-42 and 50-67 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. With regard to claims 10-42, the instant specification provides insufficient written description support for applicants new claimed negative limitation "wherein said subsequence is contained in neither residues 168-217 of SEQ ID NO:8, nor residues 1316-1520 of SEQ ID NO:8, nor SEQ ID NO:12, wherein said strand is flanked by fewer than 500 bp of native flanking sequence." Further, with regard to claims 50-67, the instant specification provides insufficient written description support for applicants new claimed negative limitation "wherein said subsequence is contained in neither SEQ ID NO:7, nucleotides 502-651, nor SEQ ID NO:7, nucleotides 3946-4560, nor SEQ ID NO:11, wherein said strand is flanked by fewer than 500 bp of native flanking sequence."

Applicants argue (page 8 of applicants response dated 5/18/99) that written description support for said claimed negative limitations is "readily ascertained for the disclosed sequences on pages 11-12 (e.g. p.11, line 8), and p.33, line 22." Applicants arguments have been fully considered but

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are not deemed to be persuasive since said disclosure on pages 11-12 of the specification provides insufficient written description for newly claimed negative limitations recited above, e.g. there is no written description of either SEQ ID No:7 or SEQ ID NO:8 on p.11, line 8 or p.33, line 22 of the specification. As set forth in MPEP § 2173.05(i), any negative limitation or exclusionary proviso must have basis in the original disclosure (see *Ex parte Grasselli*, 231 USPQ 393 (Bd. App. 1983), *aff'd mem.*, 738 F.2d 453 (Fed.Cir.1984)). Applicants do have sufficient written description support for the claimed limitations as set forth in originally filed claims 4-6 and 8 of the elected invention.

Applicants amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

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Status of Claims

5. No claim is allowed.

Any inquiry of a general nature or relating to the status of this general application should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Papers relating to this application may be submitted to Technology center 1600, Group 1645 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1096 OG 30 (November 15, 1989). Should applicant wish to FAX a response, the current FAX number for Group 1645 is (703) 308-4242.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Weatherspoon, Ph.D. whose telephone number is (703) 305-0557. The examiner can normally be reached on Monday-Friday from 8:30 AM to 5:00 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Anthony Caputa, Ph.D., can be reached at (703) 308-3995.

John Weatherspoon, Ph.D.

October 8, 1999



Anthony Caputa, Ph.D.

Supervisory Primary Examiner

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